

REMARKS

Claims 1-3, 6, 8, and 10-39 were rejected and remain pending. Reconsideration and allowance are respectfully requested.

Interview History

The Examiner disputes that it was agreed during the last interview that the amendments to Claim 1 overcame the outstanding rejection. Applicant recognizes that, in and of itself, this dispute is not determinative of the outstanding rejection. However, Applicant believes that a brief review of its history may help illuminate a point fundamental to the outstanding rejection.

Applicant's attorney Marc E. Brown had a telephonic interview with Examiner Fisher on April 8, 2008. During this interview, Applicant's attorney pointed out that good and bad experiences with a company are not "different types" of contacts, as required by the language of Claim 1 at that time. The Examiner disagreed, but indicated that the rejection might be overcome if Applicant amended the claim to use language that more clearly indicated that a customer assessment is not encompassed by the claim.¹ Applicant's attorney agreed to do.

¹ The records of Applicant's attorney reflect the following written by Applicant's attorney on the day of this interview:

The Examiner . . . contends that it would have been obvious to have stored a customer's assessment of the dealer and to have given preference to dealers that had received a positive customer assessment.

We argued that a customer's assessment of a dealer was not a "type of contact," as required by the patent claim. The Examiner disagreed. He said that a favorable or unfavorable assessment was a "type of contact," i.e., a favorable or unfavorable contact.

We agreed to amend the claim to more clearly indicate that a customer assessment is not encompassed by the claim. We agreed to fax such an amended claim to the Examiner and to again speak with him this Thursday morning.

To this extent, the recollection of Applicant's attorney and the Examiner about what took place are the same.

The Examiner further states on page 5 of the last office action that the amendments to Claim 1 that were presented in Applicant's last Amendment (filed April 18, 2008) "were not provided at the time of the interview." This is true to the extent that the Examiner is referring to the interview which took place on April 8, 2008. However, the Examiner appears to have forgotten that a subsequent interview took place two days later on April 10, 2008. In preparation for this subsequent interview, Applicant's attorney did indeed fax to the Examiner a proposed amendment to Claim 1 for discussion purposes, a copy of which is attached to this Response (including the fax confirmation establishing delivery of this fax on April 10, 2008). The amendment changed "different types" of contacts to "different reasons" for the contacts.

During this subsequent interview, the Examiner acknowledged receipt of this proposed amendment to Claim 1. The Examiner also agreed that good and bad experiences were not "different reasons" for a contact and thus that these amendments overcame the rejection.² No summary of this subsequent interview (on April 10, 2008) by the Examiner appears in the record.

Claim Rejections – 35 USC § 103

Claims 1-3, 6, 8 and 10-39 were rejected under 35 U.S.C. 103(a) as being unpatentable over Grosser et al. (U.S. Patent 6,862,552) ("Grosser") in view of Chislenko et al. (U.S. Patent 6,041,311) ("Chislenko"). This rejection is respectfully traversed and reconsideration is requested.

² The records of Applicant's attorney reflect the following written by Applicant's attorney on the day of this interview:

The Examiner agreed that the amendment that we made to claim 1 overcame the rejection that had been imposed based on Grosser.

Claim 1

Claim 1 is directed to an automated method for referring a prospective customer to automobile dealers. The customer is prompted to enter information about the customer. A database is queried using this information. The database contains information about the identity and location of automobile dealers and about prior contacts between customers and these dealers, including information about the reason for each prior contact, such as to purchase a vehicle, service a vehicle, or purchase a part. Two or more dealers with whom the customer had prior contact for different reasons are located. Information about at least one of the located dealers is provided to the customer, giving preference to the dealer(s) with whom the customer had prior contact for one of the reasons.

As explained in the specification, automated customer referral systems commonly responded to customer inquiries by referring the customer to dealers that were closest to the customer. See ¶[0010]. The invention of Claim 1 is markedly different. The automated system consults a database of contact information that contains information, not only about the existence of contacts between customers and dealers, but about the reason for each contact. The automated system then makes a referral giving preference to dealers that had contact with the prospective customer for one of the reason.

For example, an inquiring customer may be closest to dealer A, further from dealer B, and even further from dealer C. The inquiring customer may have had no prior contact with dealer A, may have visited dealer B to purchase a part, and may have phoned dealer C to purchase a vehicle. The automated system may be programmed to give preference to contacts to purchase vehicles over contacts to purchase parts. Thus, the automated system would make a referral giving preference to dealer C, even though dealer C is furthest away, and even though the customer also had contact with dealer B. The preference could be manifested by recommending only dealer C, by listing dealer C first, or by other approaches.

In short, the invention of Claim 1 makes use of customer contact data – including the reason for each contact -- from multiple dealers in a new and innovative way to increase the effectiveness of automated referrals.

Grosser was directed to computer aided decision-making. A user entered information about the user. See Col. 26, line 60 – Col. 27, line 28. The user specified a geographic area within which the user was willing to purchase a car. See Col. 28, lines 57-63. The system presented the user with a choice of dealers in that geographic area. *Id.* Information about the user was sent to the dealer selected by the user. See Col. 27, lines 36-44.

Grosser was thus an example of the typical prior art system that made referrals based on geographic location. As recognized by the Examiner, it gave no consideration whatsoever to prior contacts that the prospective customer may have had with dealers.

The combination of Grosser and Chislenko was cited in an earlier office action against an earlier version of Claim 1. See Office Action (mailed March 23, 2007). Applicant's response (filed June 5, 2007) pointed out why Chislenko did not make up for the deficiencies of Grosser. Chislenko was not cited in the next office action (mailed Nov. 28, 2007).

Chislenko still does not make up for the deficiencies of Grosser.

Chislenko recommended items to purchase. See Abstract. Chislenko gave weight to "bookmarks" to webpages which the user may have viewed, as well as to items in which other users with similar profiles expressed interest. However, Chislenko did not give preference to one dealer of those items over another – the fundamental function of the method of Claim 1.

Modifying Grosser to also recommend items – even if based on items which the user had previously seen on a webpage – would do nothing to make Grosser more similar to Claim 1. Even in combination, the method would still not recommend one

dealer over another because of differences in the reasons the prospective customer had contact with them.

The Examiner appears to nevertheless urge on page 5 of the office action that these substantial differences between Claim 1 and the applied art were merely obvious differences because "it is old and well known to know if a person has a bad experience with a company before suggesting that they deal with them." As explained during the last interview with the Examiner on April 10, 2008, however, good and bad experiences with a company are not "different reasons" for contacts with different dealers. Yet, "different reasons" – not the quality of the customers' experiences – is the criteria on which Claim 1 requires the preference for one dealer to be based. Indeed, the prospective customer may have had a wonderful experience when his car was serviced by dealer A and a horrible experience when he bought a car from dealer B. Yet, the process of Claim 1 might well give preference to dealer B because the reason for the contact was to buy a car as contrasted to servicing a car. Good and bad experiences are simply are not "different reasons" for prior contacts. The two are fundamentally different. The fact that it might have been obvious to have given preference to dealers that had good experiences with a prospective customer over those that did not, therefore, in no way, shape or form demonstrates that the much different process of Claim 1 was obvious. The Examiner agreed with this proposition during the subsequent interview on April 10, 2008, and was correct in doing so.

Claims 20, 26, and 38 are directed to systems and methods that perform steps similar to those recited in Claim 1. They too are not obvious in view of Grosser and Chislenko for reasons similar to those discussed above in connection with Claim 1.

Claims 23 and 39

Claim 23 gives preference to dealers that had a prior contact with the customer over dealers that are closer to the customer. The closer dealer is given preference only if there was no contact with a more distant dealer. Otherwise, a more distant dealer is given preference. Nothing like this is disclosed in Grosser or Chislenko, either alone or

in combination. The Examiner has also not offered any reason as to why these significant differences were merely obvious difference. Thus, a prima facie showing of obviousness has not been established. See, e.g., M.P.E.P. 2143 ("The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.").

Claim 39 is similar to Claim 23 and is not obvious in view of Grosser and Chislenko for similar reasons.

Claims 2-3, 6, 8 and 10-19, 21, 22, 24, 25 and 27-37

These claims are dependent upon Claims 1, 20, 23, 26, 38 or 39 and thus are also patentable in view of Grosser or Chislenko for the reasons stated above.

Claim 6 also requires the prior contact to which a preference is given to have been for a sales-related reason. Again, this feature is nowhere disclosed in or suggested by Grosser or Chislenko, either alone or in combination. The Examiner nevertheless urges that "it would be obvious to record that a customer had purchased a vehicle from a dealer or had service there and put that dealer at the top of the list." However, this does explain why it would have been obvious to have given preference in an automated referral system to dealers that had a prior sales relationship with the prospective customer, as compared to dealers that had been contacted for a different reason. Again, therefore, a prima facie showing of obviousness has not been established. See, e.g., M.P.E.P 2143 (quoted above).

Claim 8 also requires that a prior contact for a service-related reason be given a lower preference. Again, this feature is nowhere disclosed in or suggested by Grosser or Chislenko, either alone or in combination. The Examiner nevertheless urges that these differences would have been obvious because "a customer could like the sales [team] but dislike the service [team] or vice versa." However, this does not explain why it was obvious to have given lower preference in an automated referral system to dealers that had a prior service relationship with the prospective customer, as compared to

dealers that had been contacted for a different reason. Again, therefore, a prima facie showing of obviousness has not been established. See, e.g., M.P.E.P 2143 (quoted above).

Claims 12 and 30 also require the results to be divided into different sets, each listing dealers that had contact with the user for the same reason. The feature is also missing from Grosser or Chislenko, either alone or in combination. The Examiner merely states that this feature was obvious, but offers no reason as to why. Again, therefore, a prima facie showing of obviousness has not been established. See, e.g., M.P.E.P 2143 (quoted above).

Claims 18, 19, 36 and 37 also require preference to be given to a contact having the most recent date when contacts for the same reason with different dealers are located. This feature is also missing from Grosser or Chislenko, either alone or in combination. Again, the Examiner merely states that this feature was obvious, but offers no reason as to why. Again, therefore, a prima facie showing of obviousness has not been established. See, e.g., M.P.E.P 2143 (quoted above).

CONCLUSION

For the foregoing reasons, it is respectfully submitted that this application is now in condition for allowance and early notice of the same is earnestly requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper or any other paper or matter in this application, including extension of time fees, to Deposit Account 501946, and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP


Marc E. Brown, Registration No. 28,590

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Date: November 19, 2008

Attachment to Response to Office Action

** Transmit Conf. Report **

P.1

Apr 8 2008 10:38

Fax/Phone Number	Mode	Start	Time	Page	Result	Note
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Strategic alliance with MWE China Law Offices (Shanghai)

FACSIMILE

Date: April 8, 2008

Time Sent:

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Sent By:	DeAnna Rodriguez	Direct Phone:	(310) 788-1591
Client/Matter/Tkpr:	64706-016-6806	Original to Follow by Mail:	No
		Number of Pages, Including Cover:	3
Re:	US Patent Application No. 10/054,106		

Message:

Please see the attached request for examiner interview.

McDermott Will & Emery

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New York Orange County Rome San Diego Silicon Valley Washington, D.C.

Strategic alliance with MWE China Law Offices (Shanghai)

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Re: US Patent Application No. 10/054,106

Message:

Please see the attached request for examiner interview.

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U.S. practice conducted through McDermott Will & Emery LLP.

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Applicant Initiated Interview Request Form

Application No.: 10/054,106 First Named Applicant: CENTER, Steven S.
Examiner: FISHER, Michael J. Art Unit: 3629 Status of Application: Pending

Tentative Participants:

(1) Marc E. Brown (2) Examiner Michael J. FISHER
(3) (4)

Proposed Date of Interview: April 10, 2008 Proposed Time: 11:00 AM EST (AM/PM)

Type of Interview Requested:

(1) ☒ Telephonic (2) ☐ Personal (3) ☐ Video Conference

Please call Mr. Brown at (310) 788-1569.

Exhibit To Be Shown or Demonstrated: ☒ YES ☐ NO

If yes, provide brief description: Enclosed claim amendment.

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art Grosser	Discussed	Agreed	Not Agreed
(1) Amended Claim	1		<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2)			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3)			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4)			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/> Continuation Sheet Attached					

Brief Description of Arguments to be Presented:

Applicant has amended claim 1 to more clearly distinguish over Grosser and customer assessments of dealers.

An interview was conducted on the above-identified application on _____.

NOTE: This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

Applicant/Applicant's Representative Signature

Marc E. Brown

Typed/Printed Name of Applicant or Representative

28,590

Registration Number, if applicable

Examiner/SPE Signature

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

1. (Currently amended) An automated method for referring a prospective customer to one or more prospective dealers of automobiles and/or automobile services comprising:

a) prompting the prospective customer to enter customer information about the prospective customer;

b) receiving customer information about the prospective customer;

c) querying a database using the received customer information that contains:

1) dealer information about the identity and location of a plurality of dealers of automobiles and/or automobile services; and

2) contact information about prior contacts in the database between the prospective customer and dealers in the database, including information about the reason for each prior type of contact, such as to purchase a vehicle, service a vehicle, or purchase a part;

d) locating in the database two or more dealers with whom the prospective customer has had ~~different types of~~ prior contacts for different reasons; and

e) delivering information to the prospective customer about one or more of the located dealers, giving preference to the dealer or dealers with whom the customer has prior contacts for ~~of one of the reasons types.~~

See paragraphs [0013] and [0036] in original patent specification for support.